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EXAMINER

JOHNSON, JENNA LEIGH

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,386	<b>Applicant(s)</b> TORRES ET AL.	
	<b>Examiner</b> Jenna-Leigh Johnson	<b>Art Unit</b> 1798	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. The response filed on November 12, 2010 has been entered. Claims 12, 13, and 25 - 30 have been canceled. Claims 1 - 11 and 14 - 24 are pending. Claims 17 - 24 are withdrawn from further consideration as being drawn to a nonelected invention.

### **Response to Declaration**

2. The declaration under 37 CFR 1.132 filed November 12, 2010 is insufficient to overcome the rejection of claims 1 - 11 and 14 - 16 based upon Laurent (EP 0083960) as set forth in the last Office action because: the evidence is not considered to be persuasive. The declaration, as understood by the Examiner, summarizes the prior art, the present invention, and compares Example 1 from Laurent, with an example of the applicant's invention. The pictures accompanying the declaration show that the product formed by spraying composition 1, Laurent's Example 1, is thicker and wetter, than the product formed by spraying composition 2, which is an open, fibrous batting structure. With regards to the composition taught by Laurent and used by the applicant to create a sprayable fabric, it is noted that the composition of Example 1 is considered to be an intermediate composition and not the final composition which Laurent teaches as the sprayable composition since Examples 2 - 6 mix the composition of Example 1 with additional components such as other binders, thickeners, or fillers before making the sprayable composition. Thus, the composition of claim 1 is not taught by Laurent as being the sprayable composition, but the intermediate composition used to create the sprayable composition. Thus, the applicant must compare the compositions that Laurent teaches as sprayable to the composition of the present invention.

With regards to the previous art rejection, the Examiner argued that it would be obvious to use another known solvent instead of water as the solvent in the composition of Laurent. The declaration does not show that the composition of Laurent must be made with water. However, the declaration states that if water is used in the claimed invention, fibers and the resultant fabric would not form (paragraph 6).

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However, this is not sufficient to overcome the rejection based on Laurent since the specification clearly teaches that water can be used as a diluent to form the nonwoven fabric.

Further, the declaration argues that the composition of Laurent does not make a fabric, but more of a film. However, the term "fabric" is considered to by the Examiner to be a broad term that represents a wide range of materials. There does not appear to be any narrower definition provided by the applicant that limits or redefines the term. And while the Examiner agrees that the product formed by spraying composition 1, is structurally different from the applicant's product, there is not enough to demonstrate that the product is not a fabric in the broad definition of the term. The product includes a blend of fibers and binder to create a bonded material. And without an actual sample or further testing to show that the fibers are not interengaged or bonded together to create the larger product, the product is considered by the examiner to be a type of fabric even if it is different that the applicant's type of fabric. The claims are drawn to the general composition itself and only recite that the composition has the ability to be sprayable, how it is sprayed or what is formed when it is sprayed is considered to be intended use of the composition and does not have patentable weight with regards to the composition itself. How the composition is used or what it can produce by spraying under certain circumstances do not that structure or properties of the composition itself.

Also, the declaration states that the product of Laurent is only applied by a paint roller or low pressure gun. Again, it is noted that the claim only requires that the composition is sprayable. Further, it appears that both compositions are sprayed to form the sprayed composition, hence they are both sprayable. However, it is not clear if they were both sprayed using the same spray and nozzle conditions or if the paint spray gun describe in the spraying procedure was different from the spray gun used to create the applicant's invention. If the invention needs to be sprayed through something other than a low pressure paint gun, as taught by Laurent, it should be clear on the record that the applicant's invention underwent a different spraying process. Although for comparisons the composition should be sprayed

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through the same nozzle. Also, it is noted that the specification teaches that different solvents and different amounts of diluents require different distances to create the sprayed on fabric (page 10, lines 25 - 32). It is unclear what the exact distance for each composition was and if the amount solvent and type of solvent were taken into consideration when determining the distance between the spray nozzle and supporting surface. Further, the properties that might effect the sprayability of the composition, such as the relative amounts of certain components, the viscosity of the composition are not claimed or addressed. Although it does seem that the two composition have significantly different amounts of binder present in the compositions.

### **Claim Rejections - 35 USC § 103**

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 - 6 and 10 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurent.

Laurent teaches a sprayable composition to decorate interiors comprising fibers, water (a suitable non-toxic diluent as described by Applicant [0022 | 0050]), and polymer binder ({Laurent} Machine Translation Page 2 | Claims 1-11 | Examples 1-6). Regarding Claims 2 and 6, the binder is a polyvinyl alcohol. Regarding Claim 10, at least 40% cellulose fiber is taught for the compositions. Polyolefin fibers can be substituted for the cellulose fiber, which meets Applicant's limitation of a synthetic fiber of at least 40-% ({Laurent} Page 2). Regarding Claims 11-14, others compositions contain rockwool fibers and synthetic fibers of 82 parts weight to a binder of 100 parts weight ({Laurent} Example 4). Regarding Claim 15, a powdered calcium carbonate is used ({Laurent} Example 5).

However, Laurent fails to teach using diluents other than water. It is well known that diluents are added to mixtures to help dissolve and mix the components of the mixtures as well as control the viscosity. Further, it is known that like dissolves like, i.e., polar diluents dissolve polar materials, and that similar types of diluents, i.e., polar diluents or non-polar diluents, will dissolve a mixture with similar

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results. It is well known that lower molecular weight alcohols such as methanol, or ethanol, are similar to water since they are both polar compounds with similar end groups. Thus, one of ordinary skill in the art would have a reasonable expectation that the substitution of lower molecular weight alcohols, for the water component taught by Laurent would dissolve the composition and produced the desired mixture, with a similar ability to control and optimize the viscosity of the mixture. Further, one of ordinary skill in the art would understand that using a diluent with a lower melting point would require less energy to remove the diluent from the final product. Thus, claims 1, 2, 6, and 10 - 15 are rejected.

Laurent is silent regarding the specific properties of the composition constituents. Based on the description by Applicant regarding properties of the binder ({Applicant} [0025]), because the binder types taught by Laurent are substantially identical, they would also be expected to have similar glass transition temperatures ({Laurent} Examples 1-6). At the time of the invention, it would have been obvious to use a sprayable fiber composition and claim properties of constituent materials for the composition for forming a fabric {Laurent}. Though unrecognized at the time, the glass transition temperature of a substantially identical material is expected to be the same, and is unpatentable; see in re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). Thus, claims 3 and 4 are rejected.

Further, one with ordinary skill in the art would wish to optimize the properties of the binder, with regard to molecular weight, to help control the texture and viscosity of the composition so that the mixture can be applied to create a coating on a surface without clumping or being too thin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the molecular weight and viscosity, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Therefore, claims 5 and 16 are rejected.

5. Claims 7 - 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurent in view of O'Connell (EP 0083960).

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The features of Laurent have been set forth above. Laurent fails to teach the length of the fibers in the mixtures. O'Connell is drawn to a sprayable composition for acoustical applications comprising fibers, water, and a polymer binder ({O'Connell} Pages 4 & 6). Polyvinyl acetate and polyvinyl alcohol are taught as suitable binders to bind the fiber. The fibers have a length between about 0.5-mm to about 5-mm ({O'Connell} Page 3). Thus, it would have been obvious to choose shorter fibers with length between about 0.5 and about 5 mm, as taught by O'Connell, in the composition of Laurent. Claim 9 is unpatentable because the range is sufficiently close and there is a reasonable expectation that the fabric would have the same properties based on the similarity of the materials used; see *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Further, it would have been obvious to one having ordinary skill in the art to optimize the molecular length of fibers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). One of ordinary skill in the art would be motivated to choose a fiber length that can be easily applied as a coating onto a surface, as desired by Laurent, without being too long to clump together. Thus, claims 7 - 9 are rejected.

### **Response to Arguments**

6. Applicant's arguments filed November 12, 2010 have been fully considered but they are not persuasive. The applicant argues that the inventiveness of the composition is that the composition can be sprayed onto a supporting surface to form a fabric. This limitation is considered to be the intended use of the composition, is not considered to be a positive limitation. The patentability of the composition is determined by the chemical make-up of the composition itself and not how the composition is used. The intended use only requires that the composition has the ability to be sprayed to form a fabric, and as set forth in Laurent it can be sprayed in paint guns. Further, the term fabric is considered to include products which include multiple fibers interengaged or bonded together to create a larger final product. Thus, it

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felt that the sprayed product of Laurent would include fibers bonded together to create a larger final product.

Further, while it is noted above that the declaration shows that final product produced according to the invention has a different final product than the invention of Laurent, the declaration does not provide evidence that the composition of Laurent does not teach the claimed composition. Particularly the applicant does not show that the composition of Laurent can not be sprayed under some conditions to create some kind of fabric, whether the fabric has the same structure as the applicant's or not. The claim as written does not distinguish over the invention of Laurent. The claim drawn to the composition must be written to show how the composition itself is different from composition of Laurent and not how the sprayed product is different, since the final product is not being positively claimed and the claim is drawn to the structure of the composition and not to the structure of the sprayed fabric. Therefore, the rejections are maintained.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Johnson whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Wednesday (8:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Ortiz can be reached on (571) 272-1206. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlj  
January 12, 2011

/Jenna-Leigh Johnson/  
Primary Examiner, Art Unit 1798